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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,182	11/15/2000	Shigeyoshi Suzuki	PM 275383	8099

909 7590 04/02/2003

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EXAMINER
THORNTON, YVETTE C

ART UNIT	PAPER NUMBER
1752	8

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/712,182	SUZUKI ET AL.	
	Examiner	Art Unit	
	Yvette C. Thornton	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This is written in reference to application number 09/712182 filed on November 15, 2000.

Claim Status

1. Claims 1-16 are currently pending.

Oath/Declaration

2. The examiner acknowledges the declaration submitted pursuant to 37 CFR 1.132 by inventor Yasuo Tsubai on January 23, 2003.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Coppens et al. (US 5273858 A). Coppens teaches a method of making a lithographic aluminum offset printing plate comprising the steps of (a) photo-exposing a photosensitive mono-sheet layer assemblage comprising a hydrophilic grained and anodized aluminum foil, an intermediate layer and at least one silver halide emulsion layer; (b) applying an aqueous alkaline solution to the photo-exposed silver halide layer in the presence of at least one developing agent and at least one silver halide solvent to form a silver image and to allow unreduced silver halide to diffuse imagewise from the developed silver halide layer to the said aluminum foil; and (c) separating the said emulsion layer and said intermediate layer from the imaged aluminum foil (c. 3, l. 28-52). The said intermediate layer comprises hydrophobic polymer beads prepared by polymerization of at least

one ethylenically unsaturated monomer and having an average diameter not lower than 0.2 μm. The taught step (c) can be accomplished by several methods. One of which is by bringing the emulsion layer side of the mono-sheet layer assemblage in contact with a receiving means. The receiving means is applied during the time that the alkaline solution is being applied and removed after the silver image has been formed. The emulsion layer and the intermediate layer are wet with the said alkaline solution and have an adherence to the receiving means that is stronger than that to the imaged aluminum foil. The receiving means along with the said emulsion and intermediate layer is then peeled from the imaged hydrophilic foil (c. 3, l. 55-c. 4, l. 2). Coppens teaches that the silver halide emulsion layer can be any photosensitive silver halide emulsion comprising a hydrophilic colloid binder. Suitable halides include silver chloride, silver bromide, silver chlorobromoiodide and the like (c. 15, l. 62-67). The said binder can be gelatin, polyvinyl alcohol, polyvinyl pyrrolidone, polyacrylic acid and derivatives thereof (c. 16, l. 59-68). Example 1 exemplifies a silver halide emulsion layer comprising a cadmium-free gelatin silver chlorobromoiodide emulsion layer wherein the silver halide is coated in the amount corresponding to 2.40 g. of silver nitrae/m^2 and the gelatin (colloid binder) being 1.58/m^2 (c. 26, l. 29-47). It is the examiner's position that this exemplifies an emulsion layer having 70% or less hydrophilic colloid (i.e., gelatin) based on the silver halide in terms of silver nitrate.

5. Coppens further teaches that use of a supplemental hydrophilic colloid layer which can be coated on top of the silver halide emulsion layer remotest from the said aluminum foil. It is the examiner's position that this supplemental layer constitutes a protective layer. Coppens teaches that the receiving means can be paper or a film base coated with a hardened gelatin layer comprising a matting agent (c. 24, l. 63-c. 25, l. 2). It is the examiner's position that the said

gelatin binder meets the limitation of a peeling means, which has a liquid absorption rate at 0.1 seconds that is 60% or more than the said absorption rate at 0.2 seconds. This position is supported by the applicant's own disclosure which teaches that gelatin is a suitable binder for the said peeling means (spec. pg. 19, l. 1-10). Therefore, the examiner is of the position that the said gelatin binder would inherently meet the limitations of instant claim 1. Furthermore, the taught matting agent constitutes a dispersion of fine particles as claimed by the applicant in instant claims 3 and 5.

Response to Arguments

6. Applicant's arguments have been fully considered but they are not persuasive. In regard to the prior art teachings of Coppens, applicants argue that the prior art fails to disclose the claimed peeling means. Applicants state that Coppens only discloses a polyethylene-coated paper sheet, which has no characteristic feature as a peeling sheet. The examiner respectfully disagrees. As discussed above, Coppens teaches that the receiving means can be paper or a film base coated with a hardened gelatin layer comprising a matting agent (c. 24, l. 63-c. 25, l. 2). It is the examiner's position that the said gelatin binder meets the limitation of a peeling means, which has a liquid absorption rate at 0.1 seconds that is 60% or more than the said absorption rate at 0.2 seconds. Therefore, the examiner is of the position that the said gelatin binder would inherently meet the limitations of instant claim 1. The applicant has offered declaration evidence that the teachings of the prior art do not inherently meet the limitation of the instant claims. The said declaration has been fully considered but is unconvincing. Applicants state that the comparative example of gelatin comprising 5% silica meets the limitations of the receiving means of the prior art. The examiner has found no direction in the teachings of Coppens for

using 5% silica or 5% matting agent. The examiner is also unclear as to why silica is chosen as the taught matting agent when there are a variety of known and conventional agents available. The applicant in his own disclosure provides a vast number of examples (see spec. pg. 18, l. 11-27).

7. Further the comparative results show that 5% silica and gelatin fails to remove the photosensitive layer. The prior art of Coppens clearly teaches that the taught emulsion layer and intermediate layer are peeled from the imaged surface by the receiving means (Coppens c. 24, l. 55-58). Therefore, the examiner is of the position that 5% silica could not possibly fall within the scope of the taught invention.

8. The examiner is unable to make a direct comparison between the prior and the declaration data. The examiner finds the declaration unconvincing, therefore the rejection of record is maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 8-6:30.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

****Please note that the examiner has recently changed her name from "Clarke" to "Thornton".****

yct
April 1, 2003

JANET BAXTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700